

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Makoto TOMIOKA et al.**

Art Unit: **2621**

Application Number: **09/893,677**

Examiner: **David J. Czekaj**

Filed: **June 29, 2001**

Confirmation Number: **9414**

For: **RIGID VIDEO-ENDOSCOPE SYSTEM**

Attorney Docket Number: **010680**

Customer Number: **38834**

Appeal No. **2009-003655**

REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

October 20, 2009

Sir:

Appellants request reconsideration of the Decision mailed August 20, 2009 with respect to the present appeal.

As noted in the Decision, page 3, claims 1 and 3-18 stand rejected under 35 U.S.C. §103(a) as being obvious over Igarashi (U.S. Patent No. 5,902,232) in view of Takahashi (U.S. Patent No. 5,588,948); and claim 2 stands rejected under 35 U.S.C. §103(a) as obvious over Igarashi in view of Takahashi and Igarashi (U.S. Patent No. 5,954,634).

It is also noted, as indicated on page 9 of the Decision, that the BPAI newly relies on the disclosure illustrated in Fig. 14 of Takahashi and completely abandons the Examiner's reliance

on any teachings of the Igarashi's reference (USP 5,902,232) and the disclosure in Figs. 1 and 2 of Takahashi as set forth in the Examiner's Final rejection and the Examiner's Answer.

Also, the BPAI asserts that in sustaining a multiple-reference rejection under 35 U.S.C. §103(a), the Board may rely on one reference alone without designating the affirmance as a new ground of rejection and cites *In re Boyer* citing *In re Bush*.

In view of the above, Appellants respectfully submit that they have been given no opportunity to address the disclosure in Fig. 14 of the Takahashi reference until now, since the Examiner has failed to rely on this portion of the reference during the entire prosecution history and the BPAI did not address the subject matter of Fig. 14 of the Takahashi reference during the Oral Hearing conducted on August 12, 2009.

With regard to the disclosure set forth in Figure 14 of the Takahashi reference, the BPAI asserts the following:

For the following reasons, we find that claim 1 reads on the Figure 14 embodiment, which includes a front insertion section 2a that is rotatable with respect to the combination of rear insertion section 2b and operating/holding section 3. *Id.* At col. 9, 11. 49-52. Based on a comparison of the Figure 14 embodiment with the embodiment depicted in Figures 13(a) and (b), which show a relay lens system 7 consisting of two lenses each numbered "7," it appears that lenses 7 and 9 in Figure 14 likewise form a relay lens system. Furthermore, nothing in the language of claim 1 prevents the recited "front-end insertion section" from being read on Takahashi's front insertion section 2a (including relay lens 9) or the recited "camera head" from being read on rear insertion section 2b (including relay lens 7) in combination with operating/holding section 3, thereby satisfying the requirement of claim 1 that the "camera head" include a

part of said relay optical system and that the “front-end insertion section” include the remaining part of the relay optical system.

It is well established that claim terms “are generally given their ordinary and customary meaning” as viewed by persons of ordinary skill in the field at the time of the invention. *Phillips*, 415 F.3d at 1312-14 (quoting *Vitronics*, 90 F.3d at 1582); *see also Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004). The Patent and Trademark Office gives claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

In view of the above, it is respectfully submitted that the BPAI’s reading of the “camera head” of claim 1 on the rear insertion section 2b is improper, since persons of ordinary skill in the art would view the rear insertion section 2b as corresponding to the rear section of the front-end insertion section, and not the front section of the camera head as stipulated by the BPAI in the Decision, based on the ordinary and customary meaning of an insertion section of an endoscope at the time of the invention. That is, one of ordinary skill in the art would view the rear insertion section 2b as part of the insertion section and not as part of a camera head, since one of ordinary skill in the art would readily understand that the insertion section, including rear insertion section 2b, would be inserted within a patient during surgery or medical examination, while the camera head is external and never enters the patient. Moreover, it is submitted that this interpretation is clearly consistent with the embodiments and specification of the present

application, while the BPAI's interpretation is clearly inconsistent, since the present specification clearly discloses that the camera is always external, does not include any part of the insertion section 2 and is attached to the endoscope, which includes the insertion section 2.

Moreover, the BPAI does not address the last feature of claim 1 that requires the insertion section and the camera head to be detachable. That is, while clearly the insertion section 2a is rotatable with respect to the insertion section 2b in Fig. 14, the Takahashi reference fails to disclose or fairly suggest that the insertion sections 2a and 2b are detachable. It is submitted that for at least this reason, the BPAI reliance on one reference alone, Takahashi, for teaching each and every feature of claim 1 is lacking and is without merit.

In view of the comments above, Appellants respectfully submit that the outstanding obviousness rejections should be reversed.

No fee is believed due. Nonetheless, if payment is indeed due, such amount may be charged to Deposit Account No. 50-2866.

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Attorney Docket No. 010680

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Respectfully submitted,

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